

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| APPLICATION NO. 10/029,449 | FILING DATE 12/14/2001 | FIRST NAMED INVENTOR Ercan Sen | ATTORNEY DOCKET NO. 2001P17155US |
| Response To Notice of Non-Compliant Amendment | | | EXAMINER Haliyur, Venkatesh N. |
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REMARKS

As mentioned above, this amendment is being submitted in reply to the Notice of Non-Compliant Amendment mailed on January 24, 2006 in which certain informalities in the claim presentation were identified. This submission is being made to correct those informalities and is otherwise identical to the original response faxed November 14, 2005.

The Examiner is respectfully thanked for the thoughtful consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Each of claims 1-3 has been amended has been amended for reasons unrelated to patentability, including at least one of: addressing an informality, correcting a typographical error, and/or to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry

Each of claims 6-20 has been added. Claims 1-20 are now pending in this application. Each of claims 1, 6, and 20 are in independent form.

I. The Antecedent Basis Rejections

Claim 2 was rejected under 35 U.S.C. 112, second paragraph, as lacking sufficient antecedent basis for the limitation "said primary path" in line 1. Claim 2 has been amended solely for either addressing an informality or correcting a typographical error, thus explicitly presenting one or more elements implicit in the claim as originally written when viewed in light of the specification, and therefore not changing the scope of the claim. Thus, reconsideration and withdrawal of this rejection is respectfully requested.

II. The Obviousness Rejections

Each of claims 1-5 was rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of Grenier (U.S. Patent No. 6,654,923) and/or Marathe (U.S. Patent No. 6,882,626). These rejections are respectfully traversed.

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A. Claim Construction

On 12 July 2005, the en banc Federal Circuit, in *Phillips v. AWH Corp.*, No. 03-1269 (Fed. Cir. 2005), clarified that:

1. "[t]he Patent and Trademark Office ('PTO') determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction **'in light of the specification as it would be interpreted by one of ordinary skill in the art'**";
2. the words of a claim "are generally given their ordinary and customary meaning";
3. the ordinary and customary meaning of a claim term is "the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application";
4. "the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but **in the context of the entire patent**, including the specification";
5. even "the context in which a term is used in the asserted claim can be highly instructive";
6. "the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, **the inventor's lexicography governs**";
7. even "when guidance is not provided in explicit definitional format, **the specification may define claim terms by implication** such that the meaning may be found in or ascertained by a reading of the patent documents";
8. an "invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office"; and
9. the "prosecution history... consists of the complete record of the proceedings before the PTO and **includes the prior art cited during the examination of the patent.**"

In the present Application, the customary meaning for the phrase "ATM end system address (AESA)" is implicitly defined in the specification and the cited art. That definition must control examination of those claims that recite this phrase.

At least at page 3, the specification of the present Application implicitly defines the term "ATM end system address (AESA)" by stating, "the method establishes two redundant SVC connections through ATM Networks using the same **ATM End System Address (AESA)** from a

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source ATM End Point to a destination ATM End Point." The specification, at page 1, lines 20-28, recites that "[t]here are a number of relevant international and U.S. standards and recommendations for ATM networks, including the following: [...] ATM Form Standard AF-SIG-0061.000 (07/1996), "ATM UNI 4.0 Signaling Specification".

Andersson (U.S. Patent Number 6,912,390) is cited as prior art to the present Application in an Information Disclosure Statement filed herewith. Andersson asserts that an "ATM end system address (AESA) is described, e.g., in section 73.0 of ATM User-Network Interface (UNI) Signaling Specification, Version 74.0, AF-SIG-0061.00, July 1996, generated by the ATM Forum Technical Committee, which specifies the use of standard ATM addresses for private and public networks. In general, an AESA has an initial domain part (IDP) and a domain specific part (DSP). The initial domain part (IDP) comprises two fields: the authority and format identifier (AFI) and the initial domain identifier (IDI). The domain specific part (DSP) is subdivided into a high order DSP (HO-DSP) and a low order part which consists of the end system identifier (ESI) and a selector (SEL)." See col. 18, lines 33-45.

Thus, the phrase "ATM end system address (AESA)" should be construed as one of ordinary skill in the relevant art would interpret that term as defined, described, and/or provided in the specification and according to the context provided by patent documents in that same relevant art, such as Andersson.

A. *Prima Facie* Criteria

Grenier and Marathe do not establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." See MPEP 2143. Moreover, the USPTO "has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPOQ 173, 178 (C.C.P.A. 1967).

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B. Missing Claim Limitations

Independent claim 1 recites, yet neither Grenier nor Marathe expressly or inherently teaches or suggests, "setting up a primary SVC connection from said egress media gateway to said ingress media gateway by using a **specified ATM end system address (AESA)** of a port on said ingress media gateway over said link A" and "setting up a backup SVC connection **using the specified AESA** from said egress media gateway to said ingress media gateway over said link C."

How can either Grenier or Marathe teach or suggest "setting up a primary SVC connection from said egress media gateway to said ingress media gateway by using a **specified ATM end system address (AESA)** of a port on said ingress media gateway over said link A" and "setting up a backup SVC connection **using the specified AESA** from said egress media gateway to said ingress media gateway over said link C" when neither mentions the phrase "ATM End System Address (AESA)" at all? Likewise, how can either Grenier or Marathe teach or suggest "setting up a primary SVC connection from said egress media gateway to said ingress media gateway by using a **specified ATM end system address (AESA)** of a port on said ingress media gateway over said link A" and "setting up a backup SVC connection **using the specified AESA** from said egress media gateway to said ingress media gateway over said link C" when neither mentions addressing whatsoever?

Thus, even if there were motivation or suggestion to modify or combine the cited portions of the properly applied references (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modify the cited portions of the properly applied references (another assumption that is respectfully traversed), the cited portions of the properly applied references still do not expressly or inherently teach or suggest **every** limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness.

Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted. Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

It is respectfully noted that because the Office Action fails to set forth sufficient facts to provide a *prima facie* basis for the rejections, any future rejection based on the applied references will necessarily be factually based on an entirely different portion of those references, and thus will be legally defined as a "new grounds of rejection." Consequently, any

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Office Action containing such rejection can not properly be made final. *See In re Wiechert*, 152 U.S.P.Q. 247, 251-52 (C.C.P.A. 1967) (defining "new ground of rejection" and requiring that "when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference"), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (C.C.P.A. 1967) (the USPTO "has the initial duty of supplying the factual basis for its rejection").

Allowable Subject Matter

The following is a statement of reasons for the indication of allowable subject matter:

"none of the references of record alone or in combination disclose or suggest the combination of limitations found in the independent claims. Namely,

claims 1-5 are allowable because none of the references of record alone or in combination disclose or suggest 'setting up a primary SVC connection from said egress media gateway to said ingress media gateway by using a specified ATM end system address (AESA) of a port on said ingress media gateway over said link A' and 'setting up a backup SVC connection using the specified AESA from said egress media gateway to said ingress media gateway over said link C';

claims 6-19 are allowable because none of the references of record alone or in combination disclose or suggest 'causing a primary SVC connection to use a specified ATM end system address (AESA) at a first port on said ingress media gateway over a first set of links, said primary SVC connection between said egress media gateway and said ingress media gateway; and causing a backup SVC connection to use said specified AESA at a second port on said ingress media gateway over a second set of links, said backup SVC connection between said egress media gateway and said ingress media gateway'; and

claim 20 is allowable because none of the references of record alone or in combination disclose or suggest 'causing a primary SVC connection to use a specified ATM end system address (AESA) at a first port on said ingress media gateway over a first set of links, said primary SVC connection between said egress media gateway and said ingress media gateway, said first set of links comprising two primary links between a first ATM switch and said egress media gateway; and causing a backup SVC connection to use said specified AESA at a second port on said ingress media gateway

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over a second set of links, said backup SVC connection between said egress media gateway and said ingress media gateway, said second set of links comprising two backup links between a second ATM switch and said egress media gateway."

CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 19-2179. The Examiner is invited to contact the undersigned to discuss any matter regarding this application.

Respectfully submitted,

Dated: February 1, 2006

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